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Michael Lax

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EXAMINER

NGUYEN, THUY-VI THI

ART UNIT

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3689

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/776,583	<b>Applicant(s)</b> LAX, MICHAEL	
	<b>Examiner</b> THUY VI NGUYEN	<b>Art Unit</b> 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This is in response to the applicant's communication filed on September/22/2008, wherein applicant has elected without traverse Group I, claims 1-22, 23-32, 32-43.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1 and 23 recites the last step " *wherein said information is configured to be used by said benefit denial system to provide said benefit to said user*", It is not clear how the communicated "information/data" can be configured to provide the benefit to the user. For example, if the communicated information/data is a phrase "purchasing a CD" by "John" then, how would this "phrase" are configured to provide the benefit to the user?

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5-31 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over HODES (US 2003/0019770).

**As for independent claim 1**, HODES disclose an apparatus for use with a benefit denial system {see par 0005 *resolve the security issue relating to assets by packaging an asset in a package contains a data encoded card*} , said apparatus comprising:

a) a containing element configured to receive an asset {see figures 1-2, 11}, said asset comprising a benefit for a user of said asset {see par. 0005}; and

b) an electrical circuit comprising an antenna, said circuit operatively associated with said containing element and configured to communicate information corresponding to said asset to a receiver outside said containing element;

{HODES inherently disclose a containing element/package has a circuit and antenna/reader, e.g. *smart card 110 with computer chip, and magnetic stripe/reader*

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*which can be used for point of sale generated access to remote files/receiver out side the containing element, see figures 9, 11-14, pars. 0047, 0060, par. 0070},*

c) wherein said information is configured to be used by said benefit denial system to provide said benefit to said user {see pars. 0070, 0071, 0072, e.g. *access will be denied if code on the ID had not been activated*} .

**Note:** as for the phrase “to be used by said benefit denial system to provide said benefit to said user” is intended use and have no patentable weight in an apparatus claim.

Alternatively, since the smart card communicates to the POS terminal for generating access to remote files, it would have been obvious to replace the smart card with an electrical circuit comprising an antenna for communicating purpose as mere substituting with other similar device to achieve similar communicating/reading function.

**As for dep. claim 2**, which deals with the feature a locking element configured to lock said containing element in a closed state, this is fairly taught in HODES, see figure 11, element 26 par. 0062

**As for dep. claim 3**, which deals with the feature said electrical circuit is affixed to said locking element. HODES disclose a smartcard or computer chip is affixed on the container, except for the circuit is affixed to the locking element. It would have been obvious to one of ordinary skill in the art to locate/mount the electronic circuit feature either on the container or on the locking element of the container or any other place in the device or container to achieve the same results such as preventing the theft access in side the container or using the item/asset in side the container will be denied .

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**As for dep. claim 5**, which deals with the feature said electrical circuit/chip/smart card is affixed to the containing element, this is fairly taught in HODES, see at least figures 11, especially element 110.

**As for dep. claim 6**, which deals with the feature said electrical circuit is disposed inside said containing element when said containing element is closed; and said electrical circuit is configured to communicate said information when said containing element is closed {see par. 0059-0061}.

**As for dep. claim 7**, which deals with the feature said circuit comprises a data storage device {see par. 0060}.

**As for dep. claim 8**, which deals with the feature said circuit is further configured to communicate said information when said asset is enclosed within said containing element {see at least pars. 0060-0061, “smart card, or computer chip generated access to remote files}.

**As for dep. claims 9-11**, which deals with the feature said asset has a type; and said element is configured to enclose no more than three assets of said type, no more than two assets of said type , or no more than one asset of said type, this is fairly teach in HODE, {figures 1 and 11}. Furthermore, the term “type of asset” is not a structural element or functional structure and has no patentable weigh in an apparatus claim. See MPEP 2106.01.

**As for dep. claims 12-16**, which deals with the feature said information is required by said system to provide said benefit e.g. executable computer program, a

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game, audio data, visual data, these are fairly taught in HODES, see pars. 0072, 0077, 0078 computer software, video game, CD, DVD. Furthermore, as for these features, they are deal with type of benefit information/data which are considered as nonfunctional descriptive material and carried no patentable weights. See MPEP 2106.01.

**As for dep. claim 17**, which deals with data/information that are inactive before said system receives a portion of said information; and said system is configured to activate said data, this is fairly taught in HODES, see at least pars. 0078, disclose the inactivate data before the purchasing, and activate data by transaction manager when the device contain an asset is purchased. Furthermore, as for these features, they are deal with type of benefit information/data which are considered as nonfunctional descriptive material and carried no patentable weights. See MPEP 2106.01.

**As for dep. claim 18**, which deals with the data/information are configured to be accessed using an access device; and the system is configured to provide, after receiving the information, a data key to the device, and the key configured to activated the data, this is fairly taught in HODES, see at least pars. 0059, 0074, 0075, 0078 disclose an identification number in a card or PIN, or PAN, and merchant number. Furthermore, as for these features, they are deal with type of benefit information/data which are considered as nonfunctional descriptive material and carried no patentable weights. See MPEP 2106.01.

**As for claim 19**, which deals with said data are configured to be accessed using an access device; and, said system is configured to provide, after receiving said portion,

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a data key to said device, said key configured to activate said data, this is fairly taught in HODES, see at least pars. 0059, 0074, 0075, 0078 disclose an identification number in *a card or PIN, or PAN, and merchant number is transmit to a server*. Furthermore, as for these features, they are deal with type of benefit information/data which are considered as nonfunctional descriptive material and carried no patentable weights. See MPEP 2106.01.

**As for claims 20-21**, which deals with the containing element comprise optically opaque material, this is fairly taught in HODES, see at least par. 0063, and figure 11.

**As for claim 22**, which deals with type communication using a radio frequency signal, this is fairly taught in HODES, see at least pars. 0070, 0012-0013.

As for claim 23, HODES discloses a container for use with a system for executing a conveyance of an interest in an asset from a first party to a second party {par. 0010}, said container comprising:

a containing element configured to receive said asset {see figures 1-2, 11}; and  
an electrical circuit operatively associated with said containing element and configured to communicate information corresponding to said asset to a receiver outside said containing element;

{HODES inherently disclose a containing element/package has a circuit and antenna/reader, *e.g. smart card 110 with computer chip, and magnetic stripe/reader which can be used for point of sale generated access to remote files/receiver out side the containing element*, see figures 9, 11-14, pars. 0047, 0060, par. 0070},



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wherein said information is configured to be used by said system to execute said conveyance

{see pars. 0070, 0071, 0072, e.g. *access will be denied if code on the ID had not been activated*} .

**Note:** as for the phrase “to be used by said benefit denial system to provide said benefit to said user” is intended use and have no patentable weight in an apparatus claim.

Alternatively, since the smart card communicates to the POS terminal for generating access to remote files, it would have been obvious to replace the smart card with an electrical circuit comprising an antenna for communicating purpose as mere substituting with other similar device to achieve similar communicating/reading function.

**As for claim 24**, which deals with said electrical circuit is disposed inside said containing element when said containing element is closed; and said electrical circuit is configured to communicate said information when said containing element is closed, this is fairly taught in HODES {see par. 0059-0061}.

**As for claim 25**, which deals with the circuit is further configured to communicate said information when said asset is enclosed within said containing element, this is fairly taught in HODES {see at least par. 0060}.

**As for claims 26-27**, which deals with the information is required by said system to execute said conveyance, wherein the conveyance is a consignment sale, this is fairly taught in HODES, {see pars. 0059-0060, 0070}.

**As for claims 28-29**, which deals with the type of interest e.g. ownership interest, and a right to use the asset, these are fairly taught in HODES, at least pars. 0072,0078. Furthermore, as for these features, they are deal with type of interest/information/data which are considered as nonfunctional descriptive material and carried no patentable weights. See MPEP 2106.01.

**As for claim 30**, which deals with said circuit is configured to communicate said information before a third party surrenders said asset to said second party, this is fairly taught in HODES, see pars. 0010, 0012, 0060, 0078.

**As for claim 31**, which deals with the third party does not hold an ownership interest in said asset during said conveyance, this is fairly taught in HODES, see 0010, 0012, 0060. Furthermore, as for these features, they are deal with type of information/data which are considered as nonfunctional descriptive material and carried no patentable weights. See MPEP 2106.01.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over HODES in view of DAVIS ET AL (4,849,948) in view of LAX (US 5,598,728)

**As for dep. claim 4**, which deals with the feature said locking element is removable from said containing element. HODES discloses all the limitation as stated above, HODES further disclose the security container/device having a locking feature except for the “the locking feature is removable”. LAX disclose a similar security device/case/package having a removable locking element {see figure 4, col. 3, liens 29-30}. It would have been obvious to one of ordinary skill in the art to modify the system

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of HODES to include the removable locking element as taught by LAX for the benefit of customer convenience usage.

7. Claims 32-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over HODES in view of DAVIS ET AL (4,849,948).

**As for independent claim 32**, HODES discloses a container for an asset, said container comprising:

a containing element configured to receive said asset {see figures 1-2, 11};  
an electrical circuit operatively associated with said containing element and configured to communicate information corresponding to said asset to a receiver outside said containing element;

{HODES inherently disclose a containing element/package has a circuit and antenna/reader, *e.g. smart card 110 with computer chip, and magnetic stripe/reader which can be used for point of sale generated access to remote files/receiver out side the containing element, see figures 9, 11-14, pars. 0047, 0060, par. 0070*},

HODES further disclose claim invention as stated above except for the feature a circuit deactivator configured to interrupt electrical communication within said circuit.

DAVIS ET AL is cited to teach the inclusion of a circuit deactivator in a container (housing) wherein the circuit deactivator is used to disable (interrupt or stop) the unit's operation for a desired/predetermined function such as after a predetermined length of time, such as within the life of the battery powering the unit {see Fig. 4, element 48, abstract, col. 3, lines 1-6, }. It would have been obvious to modify the teachings of RANDELL ET AL by including a circuit deactivator as taught by Davis et al above to

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disable (interrupt or stop) the unit's operation for a desired/predetermined function such as after a predetermined length of time, such as within the life of the battery powering the unit. The selection of any other desired function such as preventing tempering or fraud would have been obvious as mere selection other desired function such as interrupting circuit communication.

**As for claim 33**, which deals with said electrical circuit is disposed inside said containing element when said containing element is closed; and said electrical circuit is configured to communicate said information when said containing element is closed, this is fairly taught in HODES, {see par. 0059-0061}.

**As for claim 34**, which deals with the said circuit is configured to communicate said information when said asset is enclosed within said containing element, this is fairly taught in HODES, {see at least pars. 0060-0061, "smart card, or computer chip generated access to remote files}.

**As for claim 35**, which deals with the interrupt electrical signal communication between two circuit devices, this is fairly taught in DAVIS ET AL, see figure 4.

**As for claims 36-37**, which deal with the first portion comprises a data storage device and second portion comprises an antenna, this is fairly taught in HODES, figure 11, pars. 0060, "storage medium and magnetic strip/reader/antenna}

**As for claims 38-39**, which deal with the deactivator is configured to interrupt said electrical communication by physically separating said first and second portions of said circuit, and manually configuration, this is fairly taught in DAVIS ET AL, figure 4, col. 3, lines 1-10}.

**As for claims 40-41**, which deal with the information is configured to be used by a benefit denial system to provide to an asset user access to a benefit and the information is required by said benefit denial system to provide said access, this is fairly taught in HODES, see pars. 0005, 0059, 0070, 0072.

**As for claims 42-43**, which deal with information is configured to be used by an asset transaction system to convey an interest in said asset from an interest conveyor to an interest receiver and said information is required by said asset transaction system, this is fairly taught in HODES, see pars. 0005, 0059-0060, 0070-0072. Furthermore, as for these features, they are deal with type of benefit information/data which are considered as nonfunctional descriptive material and carried no patentable weights. See MPEP 2106.01.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689